

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 13, 2003. Reconsideration and allowance of the application and pending claims 1, 4-24, and 30 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 1, 4-24, and 30 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielson (U.S. Patent No. 6,405,243) in view of Reilly (U.S. Pat. No. 6,427,164).

The Office Action alleges the following:

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference.

All the independent claims have been amended to read that the sending information is entered at the sending device. The claims further clarify that the sending information (recipient's address) is for identifying a destination to which information to be sent by the sending device. Applicants argued for patentability that the "recipient's old email address" is not inputted by a user at the sending device. The Examiner disagrees. See at least the abstract and figure 4 and 5 and the corresponding description in lines 60 of column 5 to line 54 of column 7 of the Nielson reference. The message to be sent to a recipient is received (step 401 of figure 4) at the sending device. The recipient's address is sent to the server for update if the message is not deliverable. This is exactly what is claimed in applicants' claims. (Emphasis in the original).

Applicant respectfully traverses this rejection.

B. Applicants' Independent Claims

Applicants' independent claims include, with emphasis added:

1. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

9. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information, and determining the identity of the user from the entry;

receiving the sending information entered by the user that identifies a destination to which information is to be sent by the sending device;

responsive to the entry, cross-referencing the sending information entered by the user with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user;

providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information; and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

15. A sending information processing system, comprising:

logic configured to receive sending information entered by a user at a sending device that identifies a destination to which electrical information is to be sent;

logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user in the database; and

logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

20. A sending information processing system, comprising:
means for receiving through entry by a user at a sending device sending information that indicates a destination to which information is to be sent;
means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the database for that user; and
means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

C. Discussion of the Rejection

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

1. Claim 1

Neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest **responsive to the entry, cross-referencing the user-entered sending information with a contacts database** that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database, and **automatically caching the user-entered sending information in the contacts database if the user-entered sending information has**

not been previously saved, as recited in claim 1. The Office Action dated 7/30/2003 alleges,

Receiving an entry (recipient's old email address) input by a user into the sending device...

In the Office Action dated 11/13/2003, the Office Action alleges,

Applicants argued for patentability that the recipient's old email address" is not inputted by a user at the sending device. The Examiner disagrees. See at least the abstract and Figure 4 and 5 and the corresponding description in lines 60 of column 5 to line 54 of column 7 of the Nielson reference. The message to be sent to a recipient is received (step 401 of figure 4) at the sending device. the recipient's address is sent to the server for update if the message is not deliverable.

The "message" referred to above is described in the specification as an error message (see col. 6, line 2). There is nothing in the cited portion that says the "old email address" is located therein. However, assuming *arguendo* that the "message" includes the recipient's email address, or that the recipient's old address was input by the user which, after being sent, prompted the error message (see col. 6, lines 1-10), there is nothing in Nielson that describes **responsive to the entry, cross-referencing the user-entered sending information with a contacts database; and automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved**, as recited in claim 1. In other words, the cross-referencing that occurs at the address change server in Nielson occurs in response to an error message, sent after an email message to the old address has been sent, which is sent, presumably, after an old email address has been entered. The cross-referencing does not occur **responsive to the entry**. Additionally, Nielson does not describe automatically caching the **user-entered sending information** (i.e., the old email

address), but instead describes a caching of the new email address (step 507 and step 509). Thus, the limitations of claim 1 have not been met by Nielson.

Reilly does not remedy the deficiencies of Nielson. Reilly similarly is concerned with forwarding email when the recipient address is unknown by the sender. In col. 9, lines 51-58, the following is disclosed:

According to another embodiment, in addition to the automatic resending the e-mail message to the new address, the sending user is notified by a new e-mail message or other various means as to the new e-mail address for the recipient. The sending user is then able to manually update their address book with the new address. Alternately, the sending user's e-mail software (or address book, or other reference table) resident on computer system 110 receives the new address and automatically updates the address book with the new e-mail address for the intended recipient (i.e., user2).

Reilly does not disclose, teach, or suggest all of the limitations of claim 1, namely **responsive to the entry, cross-referencing the user-entered sending information with a contacts database, and automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved**, as recited in claim 1. A notification of a new email address is electronically received and the new address is cached in a contacts database without any stated comparison to a contacts database (presumably because the new address was not entered yet, which is the basis of the Reilly invention). Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 1 and the claims that depend therefrom be withdrawn.

2. Claim 9

Neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest **responsive to the entry, cross-referencing the sending information entered by the user with a contacts database** that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user; **providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information**; and **automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved**, as recited in claim 9. As explained above in association with claim 1, assuming *arguendo* that the “message” in the cited portion of the Nielson reference includes the recipient’s email address, or that the recipient’s old address was input by the user which, after being sent, prompted the error message (see col. 6, lines 1-10), there is nothing in Nielson that describes **responsive to the entry, cross-referencing the sending information entered by the user with a contacts database**. A series of events must occur in Nielson before any comparison with a database is implemented, and thus it is clearly not performed in response to the entry of the old email address. Further, Nielson does not disclose, teach, or suggest **providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information** as recited in claim 9. Nielson discloses an error message and a dialog box, which neither provide previously saved sending information as a selection option. Also, Nielson does not disclose, teach, or suggest **automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved**, as recited in claim 9. As explained above, Nielson

describes caching of the new email address (step 507 and step 509), not the old email address. Thus, the limitations of claim 9 have not been met by Nielson.

Reilly does not remedy the deficiencies of Nielson. Reilly does not disclose, teach, or suggest all of the aforementioned limitations of claim 9. A notification of a new email address is electronically received and the new address is cached in a contacts database without any stated comparison to a contacts database (presumably because the new address was not entered yet, which is the basis of the Reilly invention). Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 9 and the claims that depend therefrom be withdrawn.

3. Claim 15

Neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest **logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database** that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user in the database; and **logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved**, as recited in independent claim 15. As explained above in association with claim 1, there is nothing in Nielson that describes **logic configured to, responsive to the entry, cross-reference the user-entered sending information with a contacts database**. A series of events must occur in Nielson before any comparison with a database is implemented, and thus it is clearly not performed in response to the entry of the old email address. Also, Nielson does not disclose, teach, or suggest **logic configured to automatically cache**

the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved, as recited in claim 15. As explained above, Nielson describes caching of the new email address (step 507 and step 509), not the old email address. Thus, the limitations of claim 15 have not been met by Nielson.

Reilly does not remedy the deficiencies of Nielson. Reilly does not disclose, teach, or suggest all of the aforementioned limitations of claim 15. A notification of a new email address is electronically received and the new email address is cached in a contacts database without any stated comparison to a contacts database (presumably because the new address was not entered yet, which is the basis of the Reilly invention). Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 15 and the claims that depend therefrom be withdrawn.

Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 15 and the claims that depend therefrom be withdrawn.

4. Claim 20

Neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest **means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database** that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the database for that user; and **means for automatically**

caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved, as recited in independent claim 20. As explained above in association with claim 1, there is nothing in Nielson that describes means for, responsive to the entry, cross-referencing the user-entered sending information with a contacts database. A series of events must occur in Nielson before any comparison with a database is implemented, and thus it is clearly not performed in response to the entry of the old email address. Also, Nielson does not disclose, teach, or suggest means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved. Nielson describes caching of the new email address (step 507 and step 509), not the old email address. Thus, the limitations of claim 20 have not been met by Nielson.

Reilly does not remedy the deficiency of Nielson. Reilly does not disclose, teach, or suggest all of the aforementioned limitations of claim 20. A notification of a new email address is electronically received and the new address is cached in a contacts database without any stated comparison to a contacts database (presumably because the new address was not entered yet, which is the basis of the Reilly invention). Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 20 and the claims that depend therefrom be withdrawn.

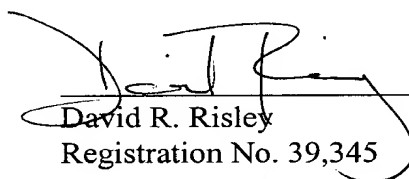
Thus, Applicants respectfully submit that neither Nielson nor Reilly, alone or in combination, disclose, teach, or suggest all of the claim limitations, and thus respectfully request that the rejection to claim 20 and the claims that depend therefrom be withdrawn.

In summary, it is Applicants' position that a proper case for obviousness has not been made against Applicants' independent claims 1, 9, 15, and 20 and claims 4-8 and 30, 10-14, 16-19, 21-24 which depend therefrom, respectively. Therefore, it is respectfully submitted that each of these claims is patentable over Nielson and Reilly and that the rejection of these claims should be withdrawn.

CONCLUSION

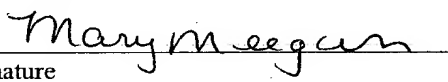
Applicant respectfully submits that pending claims 1, 4-24, and 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


David R. Risley
Registration No. 39,345

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